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END5241USNPRemarks

This amendment is being submitted with a request for continued examination (RCE) filed within 2 months of a Notice of Appeal filed December 1, 2006.

Status of Claims:

Claims 1-7, 21-32, and 34 stand finally rejected. Claims 1-2, 7, 21, 25, 29, 34 are amended. Claims 33 is added. Claims 1-7, 21-34 remain pending.

Support for the claim amendments is found in the specification and drawings as filed. For instance, but without limitation, paragraph 0047 describes use of the electrodes 412, 416 for coagulation of breast tissue, and paragraph 0029-0030 describes suitable electrode surface dimensions and suitable electrode gap dimensions. The Figures and paragraph 0032 of the specification disclose the sleeve having an open distal end. The end opening 419 is sized to receive the distal tissue piercing tip (e.g. knife 72) of the piercer 70 therethrough (see Figure 3). The Figures and Paragraph 0032 also disclose that two electrodes can be positioned on an exterior surface of the sleeve alongside the lateral opening provided by window 416, the electrodes extending lengthwise parallel to the axis of the sleeve, with at least a portion of each of the electrodes being positioned proximally of the distal most portion of the lateral opening provided by the window 416 (See for instance Figure 1). No new matter is added.

§ 102 Rejections:

Claims 1-7, 21-24, 26-32, and 34 are rejected under 35 U.S.C. §102(b) as being anticipated by Wardle et al. US2002/0120211 (Wardle). Applicant respectfully traverses these rejections.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim.

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END5241USNPClaims 1-7

Amended Claim 1 recites, in part, a hollow sleeve adapted to receive a tissue piercing element therein, with at least one electrode disposed on the sleeve, where the electrode is adapted for providing coagulation.

It is respectfully urged that Wardle does not disclose such a sleeve adapted to receive a tissue piercing element therein and an electrode disposed on the sleeve and adapted for providing coagulation. Wardle discloses a shaft 14 having a distal tip cutter 20 disposed on the distal tip of the shaft 14. (see paragraph 0029 of Wardle). It is respectfully urged that Wardle does not teach a sleeve adapted to receive a tissue piercing element therein, or that the cutter 20 is adapted for providing tissue coagulation.

Further, the Examiner states that Wardle teaches a hollow sleeve 14 adapted to receive a tissue piercing element 12 therein. It is respectfully urged that the reference number "12" in Wardle does not refer to a tissue piercing element received in the shaft 14, but instead Wardle teaches an assembly 12 which includes the shaft 14. Assembly 12 is not received in shaft 14 as the Examiner seems to maintain. (see paragraph 29 of Wardle). Accordingly, the Examiner's rejection of Claim 1 is based on a mischaracterization of Wardle.

Withdrawal of the rejection of Claim 1 and all claims depending from claim 1 is requested.

With respect to amended claim 2, it is respectfully urged that Wardle does not disclose an electrode disposed on a sleeve such that at least a portion of the electrode is positioned proximally of a distal most portion of the tissue receiving opening.

With respect to Claims 4 and 5, the Examiner states that Wardle discloses "at least two electrodes (20, 102, 114)." It is respectfully urged that this is not a correct characterization of Wardle. Wardle teaches that a tube electrode wire 102 supplies cutting loop 72 with RF power. Wardle also teaches that shaft electrode wires 114 lead to distal cutter 20. (see paragraphs 55 and

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56 of Wardle). It is respectfully urged that wires 102 and 114 are not properly cited as electrodes in rejecting Claim 4. Further, even if the wires were somehow construed to be "electrodes", Wardle would still not teach two electrodes associated with edges of a tissue receiving opening, as recited in Claim 5.

With respect to amended claim 7, it is respectfully urged that Wardle does not teach or suggest at least one electrode disposed on an outer surface of a sleeve and having an outwardly facing electrode surface, or the recited electrode surface dimensions.

Claims 21-32

Claim 21 recites, among other things, a hollow sleeve having a lateral opening configured to receive tissue, wherein the sleeve is configured to axially receive a portion of a biopsy probe instrument; and at least one electrode disposed on an outer surface of the sleeve, wherein at least a portion of the electrode is disposed proximally of a distal most portion of the lateral opening.

It is respectfully urged that Wardle does not teach or suggest such a sleeve configured to axially receive a portion of a biopsy probe, or an electrode disposed on an outer surface of the sleeve with at least a portion of the electrode disposed proximally of a distal most portion of a lateral opening in the sleeve.

Regarding amended Claim 25, it is respectfully urged that Wardle does not teach or suggest a sleeve as recited in Claim 21 having an open distal end, and that Wardle does not teach or suggest a sleeve configured to axially receive a biopsy probe such that the distal tip of the biopsy probe extends distally from the open distal end of the sleeve.

Regarding new claim 33, it is respectfully urged Wardle does not teach or suggest two electrodes, each electrode extending lengthwise in a direction parallel to the longitudinal axis of a sleeve, and at least a portion of each electrode disposed proximally of a distal most portion of a lateral opening in the sleeve.

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Claim 34

Claim 34 is amended to recite a biopsy device for obtaining a tissue sample at a sample site within a patient, the biopsy device comprising a hollow tissue piercing member, a hollow cutter translatable in the hollow tissue piercing member, and at least one electrode disposed outwardly of the hollow tissue piercing member and adapted to provide coagulation at a sample site after a tissue sample is severed by the cutter.

It is respectfully urged that Wardle does not teach or suggest such device.

Obviousness Rejections:

It is respectfully urged that the obviousness rejections of the prior office action have been overcome or otherwise obviated based at least upon the amendments and remarks above.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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